



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/228,954 01/12/99 BURNS

A 971286A

KILYK & BOWERSOX P.L.L.C.
3603-E CHAIN BRIDGE ROAD
FAIRFAX VA 22030

IM52/0118

EXAMINER

JUSKA, C

ART UNIT

PAPER NUMBER

1771

10

DATE MAILED:

01/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/228,954

Applicant(s)
Burns, Jr. et al.

Examiner
Cheryl Juska

Group Art Unit
1771



☒ Responsive to communication(s) filed on Nov 2, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 23-68 is/are pending in the application

Of the above, claim(s) 35-57 and 62 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 23-34, 58-61, and 63-68 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1771

DETAILED ACTION

Response to Amendment

1. Amendment A, submitted as Paper No. 9 on November 2, 2000, has been entered. Non-elected claims 1-22 have been cancelled. Claims 23, 58, and 63 have been amended, while new claims 64-68 have been added. Thus, the pending claims are 23-68 with claims 35-57 and 62 being withdrawn as being drawn to non-elected inventions.
2. Amendment A is sufficient to withdraw the 102 rejections set forth in sections 11 and 12 of the last Office Action, in that the cited art of Slosberg and Wentworth does not teach the newly claimed limitation to microspheres. Additionally, the other prior art rejections based upon Wentworth are also hereby withdrawn (section 16 and 17 of the last Office Action).

Election/Restriction

3. This application contains claims 35-57 and 62 drawn to an invention non-elected with traverse. A complete reply to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. It is noted that Applicant has cancelled non-elected claims 1-22 with Amendment A. However, non-elected claims 35-57 and 62 are still pending in the application.

Art Unit: 1771

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by the cited Ervin patent. Claims 23, 24, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by the cited French patent. A discussion of said rejections can be found in sections 9 and 10 of the last Office Action.

First, it is noted that, contrary to Applicant's assertion, the Ervin patent and the French patent are not equivalent disclosures (Amendment A, page 3, 7th paragraph). The French patent is equivalent to US Application 199,807 filed on November 1971, now abandoned. Ervin's US Patent 3,819,463 is a continuation-in-part of said application. Thus, the disclosures are not exactly equivalent. However, with respect to the prior art rejections, the disclosures of said patents are equivalent.

Applicant has amended independent claim 23 to limit the thermoplastic material to a polymer or copolymer of a vinyl compound. This amendment is insufficient to overcome the cited art in that both patents teach vinyl polymers as suitable for the synthetic resinous backing material containing microspheres. Specifically, Ervin teaches a copolymer of 85% vinylidene chloride, 5% ethyl acrylate and 10% butyl acrylate and a copolymer of 80% vinyl acetate and 20% diethylmaleate (col. 2, lines 14-31). Hence, said rejections are hereby maintained.

Art Unit: 1771

With respect to the anticipation rejections over the Ervin and French patents, Applicant traverses by asserting said references teach an aqueous dispersion of a latex binder while the present invention does not employ such (Amendment A, page 4, lines 4-15 and page 5, line 16- page 6, line 10). In response, it is noted that the features upon which applicant relies (i.e., non-aqueous and non-latex) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Claims 58, 59, and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by the cited Ervin and French patents.

Applicant amended independent claim 58 to include microspheres in the thermoplastic material of the secondary backing. Thus, the 102 rejections of said claims by the cited Slosberg and Wentworth patents are hereby withdrawn in that said patents do not teach the presence of microspheres. However, said claims are now anticipated by the cited Ervin and French patents, the features of which have been previously discussed.

With respect to the limitation of claim 58, wherein said secondary backing is "casted on," and the limitation of claim 59, wherein said secondary backing is "expanded," it is asserted that said limitations are method limitations within an article claim. As such, said limitations are not given patentable weight at this time. The patentability of an article does not depend upon its method of production. If the claimed article is the same as or an obvious variant of an article disclosed in the prior art, said claimed article is unpatentable even though the prior article was

Art Unit: 1771

made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the Applicant to show unobvious differences between the claimed article and the prior art article. *In re Marosi*, 218 USPQ 289, 292, (Fed. Cir. 1983).

7. Claims 66 and 67 are rejected under 35 U.S.C. 102(b) as being anticipated by the cited Ervin and French patents.

New claims 66 and 67 limit the secondary backing to a closed-cell foam. Although the cited art does not explicitly teach that the foams are closed-cell, it is reasonable to presume that the claimed limitation is inherent to the cited art. For example, Ervin teaches the backing composition may be foamed between spaced platens in a press or parallel belts in order to obtain a constant thickness (col. 2, lines 64-67 and col. 3, lines 37-45). As evidenced by page 362 of Rodriguez's *Principles of Polymer Systems*, 2nd ed., "closed-cell foams are typically produced in processes where some pressure is maintained during the cell-formation process." Additionally, Rodriguez teaches, "Most [foaming] processes produce both kinds [open and closed-cells]." Thus, it is argued that the foams of the prior art inherently possess at least some closed-cells, in that the foams are expanded under pressure by limiting the expansion to a specific thickness. Therefore, claims 66 and 67 are rejected as being anticipated by the cited art.

Art Unit: 1771

Claim Rejections - 35 USC § 102/103

8. Claim 25 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Ervin and French patents, as applied to claim 23 above. A discussion of said rejection can be found in the last Office Action, section 14.

New claims 64 and 65 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Ervin and French patents, as applied to claim 23 above.

Applicant's arguments regarding the rejection of claim 25 have been found unpersuasive. Applicant argues that such latex backed carpets, as taught by the Ervin and French patents, are directed to only broadloom carpets and not to wide-rolled or tiles (Amendment A, page 5, line 16-page 6, line 10). In response, the Examiner cites "Materials for Carpet Tile Backing," pages 81-98 by J.E. Cheetham as published in *Carpet Substrates*. Cheetham evidences that backings for carpet tiles include latex foams, polyvinyl chloride, polyurethane, bitumen, rubber, and felt-based backings (page 85 and 87). Thus, it is asserted that the disclosure by the prior art to the broad term, "carpets" with a latex backing does not exclude carpet tiles.

Additionally, it is noted that claim 25 includes a limitation to broadloom, or 12 ft. wide, carpet, which Applicant indicates is taught by the cited references. Thus, Applicant's own arguments support an anticipation rejection of claim 25.

With respect to new claims 64 and 65, which limit the claimed article to modular carpet tiles and six foot wide carpet, respectively, it is asserted that said claims are anticipated by, or in

Art Unit: 1771

the alternative, obvious over the cited prior art. Specifically, the Examiner reiterates that a general disclosure to "carpets" includes the broadloom, wide-roll, and tile carpet. Additionally, the Examiner asserts that all tile carpet is merely broadloom or wide-roll carpet, with a specialized backing for extra dimensionally stability and perhaps, adhesiveness, which is cut into the desired tile shape. Thus, at the very least, carpet tiles would have been obvious over the cited generic "carpet" disclosure of the prior art.

9. Claims 29 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Ervin and French patents, as applied to claim 23 above, and as set forth in section 15 of the last Office Action.

Applicant groups the rejection of claims 29 and 30 with the rejection of claim 25. However, Applicant fails to address said rejection directly. Hence, said rejection is hereby maintained.

10. Claims 31 and 33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Ervin and French patents, as applied to claims 23 and 32 above, and as set forth in section 17 of the last Office Action.

Claim 60 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the cited Ervin and French patents, as applied to claim 58 above.

Applicant's only traversal of said rejections are based upon the traversal of the cited art with respect to the independent claims (Amendment A, page 7, 3rd paragraph). As those

Art Unit: 1771

arguments have been refuted above, the rejections of claims 31, 33, and 60 are hereby maintained.

Claim Rejections - 35 USC § 103

11. Claims 26, 27, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Ervin and French patents, in view of the cited Levinstein and Shoshkes references, as set forth in section 18 of the last Office Action.

Applicant's only traversal of said rejections are based upon the traversal of the cited primary references with respect to the independent claims (Amendment A, page 7, sixth paragraph). As those arguments have been refuted above, the rejections of claims 26, 27, and 63 are hereby maintained.

12. Claims 26-28 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Ervin and French patents, in view of the cited Higgins reference, as set forth in section 19 of the last Office Action.

Applicant traverses said rejection by arguing the primary references do not teach the claimed vinyl-type backing and/or the modular carpet tiles, and/or six foot rolled goods and that Higgins does not make up for these deficiencies (Amendment A, page 8, third paragraph). However, the former argument has already been disputed. Additionally, it is noted that the cited Higgins patent is relied upon only for its teaching of pre-coats, intermediate backings, and reinforcing layers. Thus, the rejection is hereby maintained.

Art Unit: 1771

13. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited French patent, in view of the cited Oppermann reference, as set forth in section 20 of the last Office Action.

Applicant traverses said rejection by arguing the primary reference does not teach the claimed vinyl-type backing and/or the modular carpet tiles, and/or six foot rolled goods and that Oppermann does not make up for these deficiencies (Amendment A, page 8, sixth paragraph). However, the former argument has already been disputed. Additionally, it is noted that the cited Oppermann patent is relied upon only for its teaching of a suitable amount of blowing agent. Thus, the rejection is hereby maintained.

14. Claim 68 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Ervin and French patents, in view of the cited Levinstein and Shoshkes references, and/or in view of the cited Higgins reference, as applied to claim 63 above.

New claim 68 limits the foam to a closed-cell foam. As argued above, said limitation is inherent to the cited primary references. Thus, claim 68 is rejected over the prior art.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


Art Unit: 1771

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cheryl Juska whose telephone number is (703) 305-4472. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached at (703) 308-2414. The official fax number for this TC 1700 is (703) 872-9310 and, for After Final communications, (703) 872-9311.

cj

January 15, 2001



CHERYL JUSKA
PATENT EXAMINER